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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,565	05/16/2001	Jeffrey H. Alger	03797.00014	4100
28319	7590	11/22/2005	EXAMINER	
BANNER & WITCOFF LTD., ATTORNEYS FOR MICROSOFT 1001 G STREET, N.W. Suite 1100 WASHINGTON, DC 20001-4597			VIG, NARESH	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/859,565

Applicant(s)

ALGER ET AL.

Examiner

Naresh Vig

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-12,14-17,19-22,24-26,28 and 30-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-3,5-12,14-17,19-22,24-26,28 and 30-42 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This is reference to response received on 01 September 2005 to the office action mailed on 10 March 2005. There are 36 claims, claims 1 – 3, 5 – 12, 14 – 17, 19 – 22, 24 – 26, 28 and 30 – 42 pending for examination.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 3, 5 – 12, 14 – 17, 19 – 22 and 24 – 25, drawn to a method for distributing variations of electronic data through multiple merchants to purchasers by publishing a first variation of electronic data for a first merchant to make available to purchasers the first variation having a core portion including a browser application for retrieving and rendering content and a first merchant-specific portion; publishing a second variation of the electronic data for a second merchant to make available to purchasers, the second variation having the core portion and a second merchant-specific portion, such that the first merchant-specific portion differs from the second merchant-specific portion so that a purchaser's viewing or execution of the first variation evokes an association with the first merchant and a purchaser's viewing or execution of the second variation evokes an association with the second merchant which allows the first merchant to add the first-merchant specific portion to the core portion to

produce the first variation, and, the second merchant adds the second-merchant specific portion to the core portion to produce the second variation. In addition, a publisher provides the core portion to the first merchant with both the first-merchant specific portion and the second-merchant specific portion, and, the first merchant enables or deletes at least a part of the second-merchant specific portion to produce the first variation, classified in class 705, subclass 26.

- II. Claims 26 and 28, drawn to a computer readable medium having stored thereon a data structure, comprising a first data field containing core data such that, when executed by a computer, the computer performing one or more functions; and a second data field containing functionality branding data for modifying the performance of the functions of the core data such that the functionality branding data provides the core data with at least one function that evokes an association with a merchant, wherein the second data field contains branding information for a plurality of merchants, such that all of the branding information except for branding information relating to a single merchant must be deleted or deactivated before a computer may properly perform the one or more functions, classified in class 705, subclass 1.

- III. Claims 30 – 32, drawn to method of selling branded software comprising receiving a software application including a browser for retrieving and rendering content; branding said software application, classified in class 705, subclass I.
- IV. Claims 33 – 35, drawn to method of selling branded software comprising receiving a software application with multiple brandings, the software application including a browser for retrieving and rendering content; preventing access to at least one of the multiple brandings associated with said software application, classified in class 705, subclass 1.
- V. Claims 36 – 38, drawn to method of selling branded software comprising receiving a software application including a browser for retrieving and rendering content; adding multiple brandings to said software application; forwarding said branded software application to a user, classified in class 705, subclass 1.
- VI. Claims 39 – 42, drawn to method of branding software comprising receiving a software application including a browser for retrieving and rendering content; adding at least one branding to said software application; wherein said adding step occurs at the software application

provider, a merchant, or at the location of an end user, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II - VI are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I is directed distributing variations of electronic data and recites the limitation the first merchant enables or deletes at least a part of the second-merchant specific portion to produce the first variation.

Inventions II and I & III - VI are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention II is directed computer readable medium and does not recites the limitation the first merchant enables or deletes at least a part of the second-merchant specific portion to produce the first variation.

Inventions III and I – II & IV - VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention III is directed selling software and does not recites the limitation the first merchant enables or deletes at least a part of the second-merchant specific portion to produce the first variation, preventing access to multiple brandings associated with software application..

Inventions IV and I – III & V - VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention IV is directed selling software and recites the limitation preventing access to multiple brandings associated with software application and does not recite the limitation the first merchant enables or deletes at least a part of the second-merchant specific portion to produce the first variation.

Inventions V and I – IV & VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for

patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention V is directed selling software and recites the limitation receiving software application with multiple brandings and does not recite the limitation the first merchant enables or deletes at least a part of the second-merchant specific portion to produce the first variation.

Inventions VI and I – V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention VI is for branding software and does not recite the limitation the first merchant enables or deletes at least a part of the second-merchant specific portion to produce the first variation.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for a group is not required for other groups, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: ***

Claims 31, 34, 37 recites the limitation forwarding step includes transmitting branded software application to said user over the internet.

Claims 32, 35, 38 recites the limitation forwarding step includes selling the branded software application in a store.

Claim 40 recites the limitation adding step occurs at the software application provider.

Claim 41 recites the limitation adding step occurs at a merchant.

Claim 40 recites the limitation adding step occurs at the location of an end user.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Naresh Vig". The signature is stylized with a large, sweeping initial "N" and a distinct "V" at the end.

Naresh Vig
Examiner
Art Unit 3629

November 17, 2005